

### Remarks and Arguments

No amendments have been made to the claims. The pending claims are original claims 3-10.

#### Response to Obviousness rejection of Claim 3

Claims 3-10 were rejected under §103(a) as obvious over the combination of U.S. Patent 5,884,786 to Valyi in view of U.S. Patent 4,591,060 to Tsukada.

Applicant's claimed invention (claim 3) is directed to a preform or container neck wherein:

- "said neck being circumferentially expanded subsequent to molding,"
- said expanded neck "being at least partially crystallized subsequent to expansion," and
- "a finish ring externally secured to said neck subsequent to crystallizing."

Applicant has discovered that this combination is useful for securing the finish ring to the expanded neck, wherein:

"Crystallization in neck 22 helps maintain the geometry of the neck prior to and subsequent to assembly of finish ring 14 to the neck." (page 6, lines 20-23)

The Examiner asserts that that Valyi teaches all elements of claim 3, except "Valyi fails to teach the crystallization of the neck." Applicant agrees that Valyi fails to teach the claimed crystallization; however Valyi **also** fails to teach Applicant's claimed **expanded** (and crystallized) neck (to which the finish ring is externally secured).

The Examiner states that in Valyi: "The finish is kept from moving axially by expansion of the preform under flange 22 (column 4, lines 23-25)." However, this does not teach Applicant's claimed expanded (and crystallized) neck, to which the finish ring is externally secured ("said neck being circumferentially expanded...and a finish ring externally secured to **said** neck..."). Valyi does not teach a finish ring externally secured to an expanded neck. Instead, Valyi teaches an expanded body portion of the preform **below** bead 56 (see Fig. 4), and at least **below** the neck (upper end of body 12) around which finish 14 is positioned.

Thus, Valyi not only fails to teach Applicant's claimed crystallized neck, but also Applicant's claimed expanded neck (to which a finish ring is externally secured).

In view of this additional failure of the primary reference Valyi, Applicant respectfully asserts that the Examiner's combination of Valyi and Tsukada is insufficient because it fails to address all elements of claim 3.

While the above is sufficient to overcome the rejection, Applicant would note that the secondary reference, Tsukada, fails to teach expansion of the neck and thus cannot be relied upon to cure the deficiency of the prior asserted combination.

Furthermore, Applicant would contest the Examiner's assertion of motivation to combine Tsukada with Valyi because Tsukada, to the extent that it teaches crystallization of a neck, does not include a separate finish ring over a crystallized neck. Instead, Tsukada provides a cap over a crystallized neck, as opposed to Applicant's finish ring (externally secured to a crystallized and expanded neck). There is insufficient basis in the record to establish that Tsukada's crystallization to facilitate tightening of a cap can or should be analogized to Applicant's claimed structure and/or the problem addressed by Applicant's invention, namely the ability to maintain the geometry of an expanded neck prior to and subsequent to assembly of a finish ring to the neck.

### **Response to Double-Patenting Rejection**

The Examiner's first provisional obviousness-type rejection of claims 3-10 is based on co-pending U.S. Application 10/351,671 (published in US2004/1046673-A1) in view of Valyi and Tsukada. Applicant believes this rejection is improper for the following reasons.

First, as previously discussed, even assuming the Examiner were correct to rely on the '673 publication in such a double-patenting rejection, the Examiner admits that the '673 publication fails to claim expansion and crystallization of the neck. As previously discussed, Valyi and Tsukada, taken alone or in combination also fail to teach the claimed expanded neck to which a finish ring is externally secured. Therefore, for the reasons previously discussed, this new combination of three references is not proper because it does not account for all elements of the claim.

Still further, and as previously discussed, Applicant believes there is no motivation to combine Valyi and Tsukada.

Still further, the '673 publication is not an issued patent, and it does not claim substantially the same invention such that double-patenting is a proper rejection. Instead, the '673 publication contains claims directed to a method of making a preform assembly in which a split annular molded plastic finish ring is assembled to a preform by expanding the ring, and/or (claims directed to) a preform assembly including a split annular molded plastic finish ring externally mounted on a preform neck having body and flange portions with external diameters greater than that of the preform neck. Thus, there is no basis to contend that Applicant is extending the patent term because the "same invention" is not claimed herein. As such, Applicant does not believe that a terminal disclaimer is necessary.

The Examiner's second provisional obviousness-type double-patenting rejection is based on claims 1-17 of co-pending U.S. Application 10/375,737, published as US2004-0166264-A1, in view of Tsukada. Applicant believes that this rejection is also improper for at least the following reasons.

First, Tsukada is not properly combinable with the '264 publication because, as previously discussed, Tsukada relates to crystallizing a preform neck for attachment of a cap, which is not the subject matter of Applicant's present claims. Thus, even if the '264 publication could be relied upon for claiming a finish ring attached to an expanded preform, there is no basis in the record combine it with Tsukada's crystallization of a preform neck which relates to attachment of a cap.

Furthermore, the '264 publication is not an issued patent and does not claim substantially the same invention. Thus, a double-patenting rejection is not proper because there is no possible patent term extension of the same invention.

### **Supplemental IDS**

Applicant submits herewith a supplemental IDS.

First Applicant requests that the Examiner make of record U.S. Patent 4,591,060 to Tsukada, on which the Examiner has relied in the January 11, 2005 office action, but

(to Applicant's knowledge) has not been included in a PTO Form 892. Thus, Applicant has included it on the attached supplemental IDS.

Furthermore, Applicant submits a copy of the International Search Report and references in corresponding PCT Application PCT/US2004/02135 filed June 2, 2004. Applicant wishes to comment on the one X reference, JP-54085262 to Yoshino, which was cited against select claims. An English language abstract is enclosed (Derwent publications AN1979-60791B).

According to the English language abstract and drawings, Yoshino appears to describe a preform (Fig. 2) which is axially stretched (Fig. 3) in a neck region  $P_2$ , and to which a separate finish ring  $P_3$  (and/or  $K_1$ ) is slid over the axially extended neck portion  $P_2$  (Figs. 4 or 5). Then, an upper mouth edge of the preform  $P_3$  is bent over in the direction of arrows (Fig. 6) to hold the finish ring on the preform  $P$ . The preform body  $P_1$  is expanded below the neck and finish ring.

The Yoshino reference fails to teach or suggest Applicant's claimed circumferential expansion of a neck portion of a preform. Thus, it fails to teach or suggest the subject matter of Applicant's independent claim 3.

Applicant also submits in the supplemental IDS the prior art of record in two co-pending U.S. applications assigned to the same owner (Continental PET Technologies, Inc. or Owens-Illinois, now Graham Packaging PET Technologies Inc.), along with copies of the International Search Reports and references in the corresponding PCT applications, namely:

U.S. Application No. 10/375,737;

PCT Application No. PCT/US04/005889;

U.S. Application No. 10/351,658 (now U.S. Patent 6,884,382); and

PCT Application No. PCT/US04/001841.

Applicant respectfully requests that the Examiner consider and make of record all of the listed references.

#### **Claims 4-5**

Claims 4-5 depend on claim 3 and are patentable for at least the same reasons as claim 3.

### **Claims 6-8**

Independent method claim 6 patentably distinguishes over the prior art of record or noted herein for at least the reasons described previously with respect to claim 3. Method claim 6 recites the steps of “circumferentially expanding said neck” of a plastic preform or container, “at least partially crystallizing said neck after expansion,” and “securing a finish ring externally over said neck subsequent to said [expansion] step.” Thus, the arguments applied with respect to claim 3 similarly apply to claim 6.

Claims 7-8 depend from claim 6, and are patentable for the same reasons as claim 6.

### **Claim 9**

Independent method claim 9 patentably distinguishes over the prior art of record or noted herein in reciting the steps of “expanding said preform neck,” “at least partially crystallizing said neck subsequent to (said expansion) step,” and “securing said finish ring to an external surface of a said neck after expansion of said neck.” Claim 9 does not recite the expansion as being “circumferential,” but otherwise is distinguishable from the prior art of record and noted herein for the reasons previously given with respect to claims 3 and 6, and in reciting the claimed steps of expanding, crystallizing and securing.

### **Claim 10**

Independent claim 10 also recites a method of making a preform assembly, which is similar to claim 9 in that it does not recite that the expansion is “circumferential.” However, it patentably distinguishes over the prior art of record and noted herein for at least the same reasons as claim 9.

Reconsideration and allowance of the present claims is respectfully requested.

If the Examiner believes that a teleconference would expedite prosecution of the present application the Examiner is invited to call the Applicant’s undersigned attorney at the Examiner’s earliest convenience.

Any amendments or cancellation or submissions with respect to the claims herein is made without prejudice and is not an admission that said canceled or amended or otherwise affected subject matter is not patentable. Applicant reserves the right to pursue canceled or amended subject matter in one or more continuation divisional or continuation-in-part applications.

To the extent that Applicant has not addressed one or more assertions of the Examiner because the foregoing response renders such statements moot, Applicant wishes to note that this is not an admission as to the accuracy of such assertions.

Please grant any extensions of time required to enter this response and charge any fees in addition to fees submitted herewith that may be required to enter/allow this response and any accompanying papers to our deposit account 02-3038 and credit any overpayments thereto.

Respectfully submitted,

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